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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/884,651	06/19/2001	Brent D. Emerson	DSCK-1224-C1	3488

7590 05/23/2003
LORUSSO & LOUD
440 COMMERCIAL STREET
BOSTON, MA 02109

EXAMINER

HUNTER, ALVIN A

ART UNIT	PAPER NUMBER
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3711

DATE MAILED: 05/23/2003

9

Please find below and/or attached an Office communication concerning this application or proceeding.

AS9

Office Action Summary

Application No.

09/884,651

Applicant(s)

EMERSON ET AL.

Examiner

Alvin A. Hunter

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 03 April 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-26 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-26 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

DETAILED ACTION

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

1. Claims 1-19 and 26 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 1 and 26, it is recited that a plurality of dimples comprising sets of dimples having different diameters. The applicant has used term dimples to further define the same terms. Furthermore, it is unclear as to what the applicant is trying to convey when saying a plurality of dimples comprising sets of dimples having different diameters. Does the applicant mean that two or more dimples of different diameters comprise a set or does the diameter vary by dimple set? For examination purposes, it will be interpreted as two or more dimples of different diameters comprising a set.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1-19 and 26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sullivan et al. (USPN 6193616) in view of Kasashima et al. (USPN 6241627).

Sullivan et al. discloses a two-piece golf ball having improved playability without sacrificing durability and/or distance characteristics (See Abstract). The core of the golf ball has a Riehle compression of 72, or a PGA compression of 88, a diameter of 1.542 inches, and a weight of 36.7 grams (See Column 10, lines 15 through 39). The cover inherently has a thickness of 0.069 inches and comprises a blend of ionomers, in which a copolymer of ethylene-methacrylic acid (Surlyn® 8490) and a terpolymer of ethylene-methacrylic acid, butyl acrylate (Surlyn® 8265) are preferred (See Detailed Description of the Invention). The Surlyn® 8490 has a melt index of 2.8 gms/10 min. and Surlyn® 8265 has a melt index of 0.9 gms/ 10 min. (See Table 1 and Table 4). The entire Surlyn® blend comprises 25 to at least 15% of the copolymer and 75 to 85% of the terpolymer (See Column 12, lines 23 through 33). The cover, over the core, has a Shore C hardness of 83-84, equivalent to about Shore D 55-56 (See Table 7 and 8). The cover inherently has dimples being that to produce the ball, it has to be molded in a dimpled mold (See Column 13, lines 51 through 67). Sullivan et al. does not disclose having dimples in a polygonal configuration including triangles. Kasashima et al. discloses a golf ball having a plurality of dimples in a regular icosahedron having 20 triangles to increase the flight performance (See Abstract and Figures 1 and 2). The dimples in each triangle constitute an arrangement unit (See Column 2, lines 10 through 18). It is noted that the number of dimples are not critical but the number of dimples are preferred being 362 to 462 (See Column 3, lines 45 through 49). The first dimple has a diameter of 2 to 4 mm and a depth of 0.05 to 0.20 and the other dimples has a diameter of 3.0 to 5.0mm and a depth of 0.1 to 0.3 (See Column 4, lines 29 through 33). Figure 2

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shows a golf ball in which dimples do not intersect the great circle line. The triangles are set side by side with the vertices starting at the poles (See Figures 1 and 2). It is also noted that the dimple arrangement set forth in Figure 1 may be adjusted without departing from the ranges set forth; therefore, to have any number of rows within the triangles would constitute as a design choice. It would have been obvious to one having ordinary skill in the art at the time the invention was made add the dimples of Kasashima et al., having any number of rows, to the golf ball of Sullivan et al. in order to improve the flight performance of the golf ball.

3. Claim 20-25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Boehm (USPN 6218453) in view of Kasashima et al. (USPN 5241627).

Boehm discloses a golf ball having good distance and feel characteristics (See Summary of the Invention). The golf ball comprises a core having a PGA compression of 70 or less and a cover having a Shore D hardness of 65 or less (See Claims 1-4). The cover comprises a low flexural modulus ionomer blended with a conventional ionomer resin (See Column 10, lines 1 through 65). The low flexural modulus ionomer is an ethylene/acrylic or methacrylic acid/n- or iso-alkyl acrylate or methacrylate terpolymer, and the conventional ionomer is ethylene/acrylic or methacrylic acid copolymer (See Column 10, lines 48 through 65). One having ordinary skill in the art are aware that butyl is an alkyl group and therefore, would have been obvious to use any alkyl group to create the terpolymer, in which reduces the hardness of the blend. It is disclosed that the low flexural modulus ionomer is at most 60% of the blend (See Column 10, lines 1 through 44). Boehm et al. does not disclose having dimples in a

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polygonal configuration including triangles. Kasashima et al. discloses a golf ball having a plurality of dimples in a regular icosahedron having 20 triangles to increase the flight performance (See Abstract and Figures 1 and 2). The dimples in each triangle constitute an arrangement unit (See Column 2, lines 10 through 18). It is noted that the number of dimples are not critical but the number of dimples are preferred being 362 to 462 (See Column 3, lines 45 through 49). The first dimple has a diameter of 2 to 4 mm and a depth of 0.05 to 0.20 and the other dimples has a diameter of 3.0 to 5.0mm and a depth of 0.1 to 0.3 (See Column 4, lines 29 through 33). Figure 2 shows a golf ball in which dimples do not intersect the great circle line. The triangles are set side by side with the vertices starting at the poles (See Figures 1 and 2). It is also noted that the dimple arrangement set forth in Figure 1 may be adjusted without departing from the ranges set forth; therefore, to have any number of rows within the triangles would constitute as a design choice. It would have been obvious to one having ordinary skill in the art at the time the invention was made add the dimples of Kasashima et al., having any number of rows, to the golf ball of Boehm et al. in order to improve the flight performance of the golf ball.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double

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patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

4. Claims 1-26 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-22 of U.S. Patent No. 6383093 in view of Sullivan et al. (USPN 6193616). U.S. Patent No. 6383093 does not claim a terpolymer blended with a copolymer. Sullivan discloses a soft ionomer (made of a terpolymer) blended with a hard ionomer (made with a copolymer) in which Sullivan et al. noted that combining the soft ionomer to the hard ionomer enhances the softness of the composition (See Detailed Description of the Invention); therefore, it would have been obvious to combine a terpolymer with a copolymer in any amounts, as taught by Sullivan et al., in order to enhance the softness of the golf ball.

Response to Arguments

Applicant's arguments with respect to claims 1-22 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within

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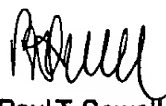
TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Alvin A. Hunter whose telephone number is 703-306-5693. The examiner can normally be reached on Monday through Friday from 7:30AM to 4:00PM Eastern Time.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Paul Sewell, can be reached on (703) 308-2126. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9302.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1148.

Alvin A. Hunter, Jr.


Paul T. Sewell
Supervisory Patent Examiner
Group 3700